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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/677,958

10/01/2003

Joe Shochet

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EXAMINER

LIU, LIN

ART UNIT

PAPER NUMBER

2145

MAIL DATE

DELIVERY MODE

10/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/677,958

Applicant(s)

SHOCHET ET AL.

Examiner

Lin Liu

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 16-21 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) 8-15, 22-23, 29-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 16-21 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/01/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/12/2004, 11/15/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 2145

DETAILED ACTION

1. This office action is responsive to communications filed on 08/30/2007.

Claims 1-7, 16-21 and 24-28 are pending and have been examined.

2. The information disclosure statement (I.D.S) filed on 02/12/2004 and 11/15/2004 are considered.

Election/Restrictions

3. Claims 8-15, 22-23, 29-43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 08/30/2007.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-7 and 24-28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "user X (first user) sends the secret code to user Y (second user) *via a mode* outside of the communication environment." (See specification, page 16, paragraph 41), does not reasonably provide enablement for "the code being transmitted by the first user to a second user outside of the multi-user communication environment". The specification

Art Unit: 2145

does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The scope of the specification discloses that the second user (user Y) is associated with the multi-user communication environment (See specification, pages 15-16, paragraphs 39-41), no support of disclosure found in the specification that states the second user (user Y) is outside of the multi-user communication environment. However, the specification discloses a method of sending the secret code from user X (first user) to user Y (second user) via a mode outside of the multi-user communication environment (See specification, page 16, paragraph 41).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by

Harvey et al. (PGPUB: US 2002/0059379 A1)

With respect to **claim 21**, Harvey teaches a multi-user communication environment for real-time communication between two users, the environment

Art Unit: 2145

comprising: an electronic locking and unlocking means that allows at least one of a real-time open or secure chat (Harvey: page 1, paragraph 4, and page 6, paragraph 57, public and private chat.).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims **1-7, 16-20 and 24-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Harvey et al. (PGPUB: US 2002/0059379 A1)** in view of **Maehiro (PGPUB: US 2002/0062348 A1)**.

With respect to **claim 1**, Harvey teaches a method for initiating communication in real-time between two users in a multi-user communication environment (Harvey: fig. 1), the method comprising:

Art Unit: 2145

providing an invitation to a first user, the invitation being transmitted by the first user to a second user outside of the multi-user communication environment (Harvey: fig. 3, page 7, paragraphs 64-66 and page 13, paragraph 127, noted that the user sends invitation to other users to join the community.);

whereby the second user initiates real-time and secure communication with the first user after the invitation is authenticated in the multi-user communication environment (Harvey: fig. 3, page 7, paragraph 66 and page 13, paragraphs 127-128, noted that the invited user is approved by the central controller and launches the application to establish a communication with the community.).

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the invitation data format as taught by Maehiro in Harvey's invention in order to allow the server to efficiently identify the area of the database (Harvey: page 1, paragraph 14).

With respect to **claim 2**, Harvey teaches the method according to claim 1, wherein the invitation is provided by the multi-user communication environment (Harvey: fig. 1, and page 7, paragraphs 64-67.).

Art Unit: 2145

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

With respect to **claim 3**, Harvey teaches the method according to claim 2, wherein the multi-user communication environment is an online multiplayer gaming environment (Harvey: fig. 6, page 4, paragraph 39 and page 12, paragraphs 121-123, gaming environment.).

With respect to **claim 4**, Harvey teaches the method according to claim 1, wherein the invitation is transmitted by the first user through at least one of an email program, a telephone conversation, a handwritten note, a chat room program, direct communication, a instant message program, and a facsimile (Harvey: page 7, paragraph 64.).

With respect to **claim 5**, Harvey teaches the method according to claim 1, wherein the first user initiates real-time and secure communication with the second user after the code is authenticated in the multi-user communication environment (Harvey: page 7, paragraph 66 and page 13, paragraphs 127-128).

With respect to **claim 6**, Harvey teaches the method according to claim 1, wherein the code comprises a sequence of symbols (Harvey: fig. 3, page 7, paragraphs 64-66 and page 13, paragraph 127, noted the invitation message.).

Art Unit: 2145

With respect to **claim 7**, Harvey teaches all of the claimed limitations, except that he does not explicitly teach that the code comprises a sequence of alpha-numeric symbols.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

With respect to **claim 16**, Harvey teaches a multi-user communication environment for real-time and secure communication between two users (Harvey: fig. 1), the environment comprising:

a server for authenticating an invitation entered by a first user (Harvey: figures 1 & 6, page 13, page 7, paragraph 66 and paragraphs 127-128, noted the central controller);

said server allowing real-time and secure communication between the first and a second user in the multi-user communication environment after the invitation is authenticated (Harvey: figures 1 & 6, page 13, page 7, paragraph 66 and paragraphs 127-128).

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the invitation data format as taught by Maehiro in Harvey's invention in order to allow the server to efficiently identify the area of the database (Harvey: page 1, paragraph 14).

With respect to **claim 17**, Harvey teaches the multi-user communication environment according to claim 16, wherein the invitation is entered in the environment via a keyboard terminal (Harvey: fig. 1, page 3, paragraph 35 and page 7, paragraph 69, keyboard.).

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

With respect to **claim 18**, Harvey teaches the multi-user communication environment according to claim 16, wherein the server provides the invitation to the second user (Harvey: page 13, page 7, paragraph 66 and paragraphs 127-128).

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39).

Art Unit: 2145

With respect to **claim 19**, Harvey teaches the multi-user communication environment according to claim 16, wherein the second user delivers the invitation to the first user by at least one of an email program, a telephone conversation, a handwritten note, a chat room program, direct communication, an instant message program, and a facsimile (Harvey: page 7, paragraph 64.).

In regard to **claim 20**, the limitations of this claim are substantially the same as those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject claim 20. By this rationale **claim 20** is rejected.

With respect to **claim 24**, Harvey teaches a readable media having instructions for facilitating communication in real-time between two users in a multi-user communication environment, the instructions performing steps comprising:

allowing the two users to communicate within the multi-user communication environment by selecting from a menu of pre-determined words (Harvey: fig. 4, page 9, paragraphs 83, & 91, noted the community GUI.);

providing an invitation to a first one of the two users, wherein the menu fails to provide for the transmission of the unique code to the other of the two users thus requiring the invitation to be transmitted by the first one of the two users to the other of the two users outside of the multi-user communication environment (Harvey: fig. 3, page 7, paragraphs 64-66 and page 13, paragraph 127, noted that the user sends invitation to other users to join the community.);
and

Art Unit: 2145

allowing the other of the two users to transmit free form communications to the first one of the two users upon the other of the two users authenticating the invitation with the multi-user communication environment (Harvey: fig. 3, page 7, paragraph 66 and page 13, paragraphs 127-128, noted that the invited user is approved by the central controller and launches the application to establish a communication with the community.).

However, Harvey does not explicitly teach that the invitation comprise of a unique code.

In the same field of endeavor, Maehiro teaches that the invitation comprise of a unique code (Maehiro: fig. 5, page 1, paragraphs 11 and 14, and page 3, paragraphs 38-39, noted that the invitation data format includes user ID number.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the invitation data format as taught by Maehiro in Harvey's invention in order to allow the server to efficiently identify the area of the database (Harvey: page 1, paragraph 14).

In regard to **claim 25**, the limitations of this claim are substantially the same as those in claim 6. Therefore the same rationale for rejecting claim 6 is used to reject claim 25. By this rationale **claim 25** is rejected.

In regard to **claim 26**, the limitations of this claim are substantially the same as those in claim 3. Therefore the same rationale for rejecting claim 3 is used to reject claim 26. By this rationale **claim 26** is rejected.

Art Unit: 2145

With respect to **claim 27**, Harvey teaches the readable media according to claim 24, wherein the invitation is provided in response to a request by the first one of the two users (Harvey: fig. 3, page 7, paragraphs 64-66 and page 13, paragraph 127).

With respect to **claim 28**, Harvey teaches the readable media according to claim 24, wherein the unique code is valid for a limited period of time (Harvey: fig. 5, page 11, paragraphs 112-113).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Harvey et al. (Patent no.: US 6,784,901 B1) discloses a method for the delivery of a chat message in a 3D multi-user environment.
- Multerer et al. (PGPUB: US 2002/0126846 A1) discloses a multiple user authentication for online console-based gaming sytem.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lin Liu whose telephone number is (571) 270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The

Art Unit: 2145

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LL


JASON CARDONE
SUPERVISORY PATENT EXAMINER